

PTO/SB/17 (12-04v2)
Approved for use through 7/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no person are required to respond to a collection of information unless it displays a valid OMB control number.

Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818). FEE TRANSMITTAL For FY 2005		Complete if Known	
		Application Number	10/698,481-Conf. #3225
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Filing Date	November 3, 2003
TOTAL AMOUNT OF PAYMENT (\$) 500.00		First Named Inventor	Hideaki MURAKAMI
		Examiner Name	M. Torres
		Art Unit	3683
		Attorney Docket No.	1163-0479P

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☐ Deposit Account Deposit Account Number: **02-2448** Deposit Account Name: **Birch, Stewart, Kolasch & Birch, LLP**

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)** **Multiple Dependent Claims**

_____ - = _____ x _____ = _____ **Fee (\$)** **Fee Paid (\$)**

Indep. Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**

_____ - = _____ x _____ = _____

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____	_____	_____ / 50	_____ (round up to a whole number) x _____	_____

4. OTHER FEE(S)

	Fees Paid (\$)
Non-English Specification, \$130 fee (no small-entity discount)	
Other (e.g., late filing surcharge) \$1402 Filing a brief in support of an appeal	500.00

SUBMITTED BY			
Signature		Registration No. (Attorney/Agent)	40,439
Name (Print/Type)	D. Richard Anderson	Telephone	(703) 205-8000
		Date	May 24, 2006



MS APPEAL BRIEF - PATENTS
Docket No.: 1163-0479P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hideaki MURAKAMI

Application No.: 10/698,481

Confirmation No.: 3225

Filed: November 3, 2003

Art Unit: 3683

For: CUSHIONING BODY

Examiner: M. Torres

APPEAL BRIEF TRANSMITTAL FORM

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is an Appeal Brief on behalf of the Appellants in connection with the above-identified application.

☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

A Notice of Appeal was filed on February 24, 2006.

☐ Applicant claims small entity status in accordance with 37 C.F.R. § 1.27.

The fee has been calculated as shown below:

☐ Extension of time fee pursuant to 37 C.F.R. §§ 1.17 and 1.136(a) - \$_____.

☒ Fee for filing an Appeal Brief - \$500.00 (large entity).

Application No.: 10/698,481

Docket No.: 1163-0479P

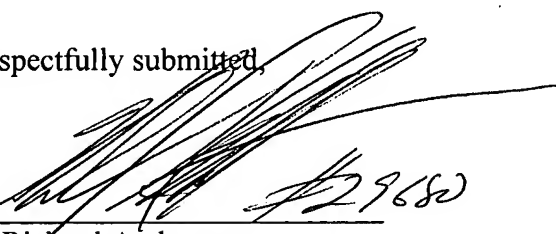
☒ Check(s) in the amount of \$500.00 is attached.

☐ Please charge Deposit Account No. 02-2448 in the amount of \$500.00. A triplicate copy of this sheet is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: May 24, 2006

Respectfully submitted,

By 
D. Richard Anderson
Registration No.: 40,439
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Attachment(s)



PATENT
1163-0479P

IN THE U.S. PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

BEFORE THE BOARD OF APPEALS

Hideaki MURAKAMI

Appeal No.:

APPL. NO.: 10/698,481

GROUP: 3683

FILED: November 3, 2003

EXAMINER: M. TORRES

FOR: CUSHIONING BODY

APPEAL BRIEF

As required under § 41.37(a), this brief is filed more than two months after the Notice of Appeal filed in this case on February 24, 2005, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

05/25/2006 SZEWDIE1 00000029 10698481

01 FC:1402

500.00 OP

Table of Contents

I.	REAL PARTY IN INTEREST.....	1
II.	RELATED APPEALS AND INTERFERENCES	1
III.	STATUS OF CLAIMS.....	1
IV.	STATUS OF AMENDMENTS.....	2
V.	SUMMARY OF THE CLAIMED INVENTION	2
VI.	THE GROUNDS OF REJECTION.....	3
VII.	ARGUMENT.....	3
A.	Issue (1): Claims 1, 5, 6, 8-10, and 13 are not anticipated by <i>Umezawa</i>	3
1.	Argument Summary	3
2.	The Legal Requirements of Prima Facie Anticipation	4
3.	The Rejection Fails to Establish Prima Facie Anticipation of Independent Claim 1	4
a.	<i>Umezawa</i> fails to explicitly teach a heat radiating elastic member arranged around an electromagnetic wave generating unit to provide cushioning for protection from physical shock as recited in claim 1.....	5
b.	<i>Umezawa</i> fails to inherently teach a heat radiating elastic member arranged around an electromagnetic wave generating unit to provide cushioning for protection from physical shock as recited in claim 1.....	6
4.	The Rejection Fails to Establish <i>Prima Facie</i> Anticipation of Dependent Claim 5	8
5.	The Rejection Fails to Establish <i>Prima Facie</i> Anticipation of Dependent Claim 6	9
6.	The Rejection Fails to Establish <i>Prima Facie</i> Anticipation of Dependent Claim 9	9
7.	The Rejection Fails to Establish <i>Prima Facie</i> Anticipation of Dependent Claim 10	10
8.	The Rejection Fails to Establish <i>Prima Facie</i> Anticipation of Independent Claim 13	11

B.	Issue (2): The <i>Umezawa-Hsu</i> Rejection	11
1.	Argument Summary	11
2.	The Legal Requirements of <i>Prima Facie</i> Obviousness.....	12
3.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Dependent Claim 12	13
a.	The cited references fail to teach or suggest all of the claim elements	13
b.	There is no motivation to combine the references in support of the rejection of claim 12	14
c.	The rejection of claim 12 relies on impermissible hindsight.....	14
4.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Dependent Claim 14	14
a.	The Examiner fails to address any elements as recited in claim 1415	
b.	There is no motivation to combine the references in support of the rejection of claim 14	15
c.	The rejection of claim 14 relies on impermissible hindsight.....	16
5.	The Rejection Fails to Establish <i>Prima Facie</i> Obviousness of Dependent Claim 11	16
X.	CONCLUSION	17
	CLAIMS APPENDIX A	1
	EVIDENCE APPENDIX B.....	4
	RELATED PROCEEDINGS APPENDIX C	5

IN RE APPLICATION OF

BEFORE THE BOARD OF APPEALS

Hideaki MURAKAMI

Appeal No.:

APPL. NO.: 10/698,481

GROUP: 3683

FILED: November 3, 2003

EXAMINER: M. TORRES

FOR: CUSHIONING BODY

**APPEAL BRIEF ON BEHALF
OF APPELLANT:
HIDEAKI MURAKAMI**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I. REAL PARTY IN INTEREST

The real party in interest for this application is the Assignee, Mitsubishi Denki Kabushiki Kaisha, 2-3 Marunouchi 2-chome, Chiyoda-ku, Tokyo, 100-8310, JAPAN.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences pending with respect to the subject matter of the present application.

III. STATUS OF CLAIMS

Claims 1-7 and 9-14 are pending in this application. Claims 2-4 and 7 are withdrawn from consideration. Claims 1 and 13 are independent. No claims have been allowed.

IV. STATUS OF AMENDMENTS

No amendments have been presented after the final Official Action.

V. SUMMARY OF THE CLAIMED INVENTION

An embodiment of the invention of the subject application is a cushioning body (4) comprising a heat radiating elastic member (5) arranged around an electromagnetic wave generating unit (8) to provide cushioning for protection from physical shock and radiate heat generated by the electromagnetic wave generating unit; and an electromagnetic wave blocking member (6) arranged in the heat radiating elastic member. [Page 4, line 21 – Page 5, line 110; Page 6, lines 7-14; Page 7, lines 15-23.]

The electromagnetic wave blocking member may be a metal sheet (13) arranged in the heat radiating elastic member. [Page 13, line 30 – Page 14, line 6.]

The metal sheet may have a roughened surface. [Page 14, lines 12-21.]

The heat radiating elastic member may have resistance to heat generated by the electromagnetic wave generating unit. [Page 7, lines 20-23.]

The heat radiating elastic member may isolate the electromagnetic wave generating unit from vibrations. [Page 7, lines 15-17.]

The electromagnetic wave generating unit may be arranged on one side of the cushioning body and the board may be arranged on another side of the cushioning body. [Page 12, lines 14-18].

Another embodiment of the invention of the subject application may be directed to a container (4) comprising a heat radiating receptacle (5) which radiates heat generated by a content (8) not to heat up the content and provides cushioning for protection from physical

shock; and a shield (6) which isolates electromagnetic waves which is included in the receptacle.

[Page 9, line 17 – Page 10, line 8.]

The container may further include a board wherein the content is arranged on one side of the container and the board (2) is arranged on another side of the container. [Page 11, lines 23-29.]

This description of the invention has been submitted to comply with the Patent Office rules for submitting Appeal Briefs. This summary of the invention should not be considered as limiting the claimed invention.

VI. THE GROUNDS OF REJECTION

The Examiner has rejected all pending claims as follows:

1. Claims 1, 5, 6, 8-10, and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated over U.S. Patent No. 6,740,606 to *Umezawa et al.* (hereinafter “*Umezawa*”); and
2. Claims 11, 12, and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Umezawa* in view of U.S. Patent No. 6,269,008 to *Hsu* (hereinafter “*Hsu*”).

VII. ARGUMENT

A. Issue (1): Claims 1, 5, 6, 8-10, and 13 are not anticipated by *Umezawa*

1. Argument Summary

The reasoning provided in support of the rejection of claims 1, 5, 6, and 8-10 under 35 U.S.C. § 102(b) as being anticipated by *Umezawa* fails to establish *prima facie* anticipation. Generally, the deficiencies of the rejection are that: (i) the rejection attributes certain claimed features to the cited reference, *Umezawa*, that a detailed reading of the reference reveals are not taught therein; (ii) the reference fails to inherently teach the missing element. Such deficiencies exist for the rejection of each of claims 1, 5, 6, and 8-10.

2. The Legal Requirements of Prima Facie Anticipation

In order to properly anticipate Appellants' claimed invention under 35 U.S.C. § 102(b), each and every element of the claim in issue must be found, either expressly described or under the principles of inherency, in a single prior art reference *Verdegaal Bros. v. Union Oil Co. of California*, 814, F.2d 628, 631, 2 USPQ.2d 1051 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claims." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ.2d 1913 (Fed. Cir. 1989). Finally, the elements must be arranged as required by the claims, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ.2d 1566 (Fed. Cir. 1990).

It is respectfully submitted that the court in *In re Robertson* held "to establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

3. The Rejection Fails to Establish Prima Facie Anticipation of Independent Claim 1

Independent claim 1 is directed to a cushioning body comprising a heat radiating elastic member arranged around an electromagnetic wave generating unit to provide cushioning for protection from physical shock and radiate heat generated by the electromagnetic wave

generating unit; and an electromagnetic wave blocking member arranged in the heat radiating elastic member.

In maintaining the rejection of independent claim 1 based on *Umezawa*, the Final Office Action of September 30, 2005, asserts on page 2 that:

Re claims 1, 5, 6, and 8-10 and 13 *Umezawa et al.* teach a cushioning body comprising: a heat radiating elastic member (2) capable of being arranged around an electromagnetic wave generating unit to provide cushioning for protection from physical shock and radiate heat generated by the electromagnetic wave generating unit to; and an electromagnetic wave blocking member (3) arranged in the heat resistant elastic member (column 14, Embodiment 4)

Appellant disagrees that *Umezawa* discloses a heat radiating elastic member arranged around an electromagnetic wave generating unit to provide cushioning for protection from physical shock as required by independent claim 1.

- a. *Umezawa* fails to **explicitly** teach a heat radiating elastic member arranged around an electromagnetic wave generating unit to provide cushioning for protection from physical shock as recited in claim 1

Appellant respectfully asserts that *Umezawa* merely discloses a laminated sheet and a process of making said sheet, which yields electromagnetic waves by embedding a conductive mesh 3 within a thermoplastic resin layer 2 for forming the laminated sheet (column 3, lines 4-7; Fig. 3). *Umezawa* further discloses a variety of different embodiments, wherein the thermoplastic sheet has different hardness properties. For example, one embodiment utilizes an acrylic-type thermoplastic resin combination having superior surface hardness, weather resistance, transparency, flexibility, and load temperature characteristics (column 5, lines 16-20). In further describing another embodiment at col. 14, lines 4-32, *Umezawa* discloses as follows:

Embodiment 4

As the thermoplastic resin sheet 12, an olefin-type elastomer sheet containing 40 parts by weight of JSR DYNARON (product name; registered trade mark) manufactured by Japan Synthetic Rubber Co. Ltd., and 60 parts by weight of polypropylene was prepared. The thickness of this sheet was 0.2 mm. JSR DYNARON is hydrogenated styrene-butadiene rubber.

This olefin-type elastomer sheet and a conductive mesh-like sheet the same as that used in Embodiment 1 were used and a laminated sheet was obtained in the same way as in Embodiment 2. However, the heating temperature was 110.degree. C. and the applied pressure was 75 kg/cm.sup.2.

As shown in FIG. 6, this laminated sheet 1 is a flat sheet in which the side 3a of the conductive mesh 3 is imbedded within the resin layer 2 which contains 40% hydrogenated styrene-butadiene rubber, and the other side 3b of conductive mesh 3 has many exposed portions 3' of conductive mesh 3 which is uniformly exposed across the entire side 3b above the resin layer 2.

The flexibility of this laminated sheet of the present Embodiment 4 is inferior to that of laminated sheet of Embodiment 3 but it is superior to that of the laminated sheet of Embodiment 1.

After cutting this laminated sheet to a desired size, it was fitted to the window of a portable telephone and it was possible to use it as an electromagnetic wave shielding window.

In embodiment 4, *Umezawa* discloses utilizing a thermoplastic resin sheet 12, which is an olefin-type elastomer sheet containing 40 parts by weight of JSR DYNARON and 60 parts by weight of polypropylene. While this material may have flexible properties and may not be as hard as the other embodiments disclosed by the *Umezawa*, Appellant maintains *Umezawa* fails to disclose "a heat radiating elastic member ... to provide cushioning for protection from physical shock ...," as recited in claims 1 and 13 (emphasis added).

- b. *Umezawa* fails to **inherently** teach a heat radiating elastic member arranged around an electromagnetic wave generating unit to provide cushioning for protection from physical shock as recited in claim 1

The Examiner asserts that in embodiment 4, the use of rubber would inherently provide cushioning for protection from physical shock (Final Office Action of September 30, 2005, Page

3, para. no. 5). Appellant respectfully disagrees with the Examiner and submits that this interpretation is clearly flawed.

Umezawa is silent with respect to using the thermoplastic resin sheet 12 as a cushioning member. *Umezawa* discloses that the thickness of resin sheet is merely .2 mm, which is clearly too thin to provide cushioning from physical shock. As *Umezawa* further discloses, the laminated sheet of this thickness is cut to a desired size and fitted to the window of a portable telephone to be used as an electromagnetic wave shielding window (column 14, lines 29-32). The application of this embodiment in no way contemplates a cushioning function, nor is it inherent given the sparse thickness of the material.

As further evidence that *Umezawa's* electromagnetic shielding, thermoplastic laminated sheets do not provide cushioning properties, *Umezawa* discloses in embodiment 5 that during the manufacturing of such sheets, a cushion material of silicon rubber which is 3 mm thick is positioned on the surface of a metal bottom molding plate 10. If the laminate sheets, as the Examiner asserts, had cushioning properties, there would be no need to supply a 3 mm thick sheet of silicon rubber as a cushioning material during the laminate sheets' manufacture. (See column 14, lines 53-57.) Appellant therefore submits that *Umezawa* actually teaches away from having the thermoplastic resin sheet providing cushioning from physical shock and vibration.

Moreover, in embodiment 3, *Umezawa* further discloses a soft laminated sheet 1 in which one side of a conductive mesh is embedded in one side of the uniform resin layer which comprises an acrylic-type resin containing hydrogenated elastomer. As with the previously discussed embodiment 4, the thickness of the resin layer 2 is approximately .2 mm. (See column 13, lines 34-39; Figs. 3 and 4.) For embodiment 3, *Umezawa* discloses using a plurality of such soft laminated sheets to fashion a bag-shaped cover. This bag-shaped cover was used as an

electromagnetic wave shielding to cover material for medical devices. In this embodiment, similar to the embodiment 4 discussed above, the laminated sheets are too thin to provide cushioning from protection from physical shock.

As such, Appellant respectfully submits that it does not necessarily flow that the use such laminates would provide cushioning for protection from physical shock, as required by the claim.

For all of the reasons set forth above, Appellant respectfully submits that, as *Umezawa* fails to teach or suggest all of the claim elements, claim 1 is not anticipated by *Umezawa*.

4. The Rejection Fails to Establish *Prima Facie* Anticipation of Dependent Claim 5

Claim 5 depends directly from claim 1. Appellant submits that the rejection under 35 U.S.C. § 102(b) based on the teachings of *Umezawa* fails to establish *prima facie* anticipation of claim 5 for at least the reasons set forth above concerning claim 1. Appellant also submits that dependent claim 5 is separately patentable and offers the following additional argument for the invention of claim 5.

The invention of claim 5 provides that the electromagnetic wave blocking member is a metal sheet arranged in the heat resistant elastic member.

In support of the Examiner's rejection of claim 5, the Examiner asserts in the Final Official Action mailed September 30, 2005 on page 2,

Re claim 5, *Umezawa et al.* teach wherein the electromagnetic wave blocking member (3) is a metal sheet arranged in the heat resistant elastic member.

Umezawa merely discloses a conductive mesh which is insufficient to anticipate the element "wherein the electromagnetic wave blocking member (3) is a metal sheet arranged in the heat resistant elastic member," as required by the claim. As such, Appellant respectfully submits that claim 5 is allowable over *Umezawa*.

5. The Rejection Fails to Establish *Prima Facie* Anticipation of Dependent Claim 6

Claim 6 depends indirectly from claim 1. Appellant submits that the rejection under 35 U.S.C. § 102(b) based on the teachings of Umezawa fails to establish *prima facie* anticipation of claim 6 for at least the reasons set forth above concerning claim 1. Appellant also submits that dependent claim 6 is separately patentable and offers the following additional argument for the invention of claim 6.

The invention of claim 6 provides that the metal sheet has a roughened surface.

In support of the Examiner's rejection of claim 6, the Examiner asserts in the Final Official Action mailed September 30, 2005 on page 2,

Re claim 6, Umezawa et al. teach wherein the metal sheet 3 has a roughened surface.

As noted above, Umezawa fails to teach a metal sheet. Further, there is no disclosure in *Umezawa* that teaches or suggests a metal sheet having a roughened surface. As such, Appellant respectfully submits that claim 6 is allowable over *Umezawa*.

6. The Rejection Fails to Establish *Prima Facie* Anticipation of Dependent Claim 9

Claim 9 depends directly from claim 1. Appellant submits that the rejection under 35 U.S.C. § 102(b) based on the teachings of *Umezawa* fails to establish *prima facie* anticipation of claim 9 for at least the reasons set forth above concerning claim 1. Appellant also submits that dependent claim 9 is separately patentable and offers the following additional argument for the invention of claim 9.

The invention of claim 9 provides the heat radiating elastic member having resistance to heat generated by the electromagnetic wave generating unit.

In the Final Official Action mailed September 30, 2005, the Examiner fails to consider any of the elements recited in the claim.

Umezawa merely discloses that thermoplastic resin sheet 12 has a resin layer 2 which has uniform thermal properties (col. 2, line 62 through col. 3, line 2). However, there is no teaching or suggestion in *Umezawa* that is directed to the heat radiating elastic member having resistance to heat generated by the electromagnetic wave generating unit as required by the claim. As such, Appellant respectfully submits that claim 9 is allowable over *Umezawa*.

7. The Rejection Fails to Establish *Prima Facie* Anticipation of Dependent Claim 10

Claim 10 depends directly from claim 1. Appellant submits that the rejection under 35 U.S.C. § 102(b) based on the teachings of *Umezawa* fails to establish *prima facie* anticipation of claim 10 for at least the reasons set forth above concerning claim 1. Appellant also submits that dependent claim 10 is separately patentable and offers the following additional argument for the invention of claim 10.

The invention of claim 10 provides the heat radiating elastic member isolates the electromagnetic wave generating unit from vibrations.

In the Final Official Action mailed September 30, 2005, the Examiner fails to consider any of the elements recited in the claim.

There is no teaching or suggestion in *Umezawa* that even discusses vibration. Appellant maintains that *Umezawa* fails to teach or suggest the heat radiating elastic member isolates the electromagnetic wave generating unit from vibrations as required by the claim. As such, Appellant respectfully submits that claim 10 is allowable over *Umezawa*.

8. The Rejection Fails to Establish *Prima Facie* Anticipation of Independent Claim 13

Independent claim 13 is directed to a container comprising a heat radiating receptacle which radiates heat generated by a content not to heat up the content and provides cushioning for protection from physical shock; and a shield which isolates electromagnetic waves which is included in the receptacle.

As noted above with regard to claim 1, *Umezawa* fails to teach or suggest any cushioning member. As such, Appellant maintains that *Umezawa* fails to teach or suggest comprising a heat radiating receptacle that provides cushioning for protection from physical shock, as required by claim 13.

Further, as noted above with regard to claim 1, *Umezawa* fails to teach or the heat radiating elastic member arranged to radiate heat. As such, Appellant maintains that *Umezawa* fails to teach or suggest a heat radiating receptacle which radiates heat generated by a content not to heat up the content, as required by claim 13.

As the Examiner has failed to provide a reference that teaches all of the claim elements, Appellant respectfully submits that claim 13 is allowable over *Umezawa*.

B. Issue (2): The *Umezawa-Hsu* Rejection

1. Argument Summary

The reasoning provided in support of the rejection of claims 11-12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over *Umezawa* in view of *Hsu* fails to establish *prima facie* obviousness for the following reasons: (i) the rejection is deficient because the rejection attributes certain claimed features to the cited references that a detailed reading of the references reveals are not taught therein; (ii) when the nature and purpose of the cushioning body as disclosed in *Umezawa* is recognized, it is evident that there is no suggestion or motivation in the

prior art references cited in support of the rejection or in knowledge generally available to those skilled in the art to modify *Umezawa* in a manner asserted in the rejection; and (iii) by asserting that certain modifications to the information input device of *Umezawa* would have been obvious without a suggestion in the applied references or elsewhere to make the asserted modifications, the rejection appears to rely on impermissible hindsight reasoning.

2. The Legal Requirements of Prima Facie Obviousness

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of the prior art must be supported by some teaching, suggestion, or motivation in the applied references or in knowledge generally available to one skilled in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The prior art must suggest the desirability of the modification in order to establish a *prima facie* case of obviousness. In re Brouwer, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). It can also be said that the prior art must collectively suggest or point to the claimed invention to support a finding of obviousness. In re Hedges, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Ehrreich, 590 F.2d 902, 908-909, 200 USPQ 504, 510 (C.C.P.A. 1979).

The teaching or suggestion to make the asserted combination or modification of the primary reference must be found in the prior art and cannot be gleaned from applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In other words, the use of hindsight to reconstruct the claimed invention is impermissible. Uniroyal Inc. v. Rudlan-Wiley Corp., 5 USPQ 1434 (Fed. Cir. 1983).

Finally, when considering the differences between the primary reference and the claimed invention, the question for assessing obviousness is not whether the differences themselves

would be been obvious, but instead whether the claimed invention as a whole would have been obvious. Stratoflex Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983).

3. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 12

a. The cited references fail to teach or suggest all of the claim elements

Claim 12 depends indirectly from claim 1. Appellant submits that the rejection under 35 U.S.C. § 103(a) based on the combination of *Umezawa* in view of *Hsu* fails to establish *prima facie* obviousness of claim 12 for at least the reasons set forth above concerning claim 1. Appellant also submits that dependent claim 12 is separately patentable and offers the following additional argument for the invention of claim 12.

The invention of claim 12 is directed to the electromagnetic wave generating unit is arranged on one side of the cushioning body and the board is arranged on another side of the cushioning body.

In support of the Examiner's rejection of claim 12, the Examiner asserts in the Final Official Action mailed September 30, 2005, on page 3 as follows:

Re claims 11, 12 and 14, *Umezawa et al.* teaches wherein the invention is used for electronic devices. However, *Umezawa et al.* does not teach wherein the equipment comprises a board. *Hsu* teaches where a container with a shield (100) comprises a board (52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a board in the invention of *Umezawa et al.* since it is well known to those of ordinary skill in the art that shields are used with boards in order to reduce interference among components.

The Examiner fails to address any elements as recited in claim 12.

As noted above with regard to claim 1, *Umezawa* fails to teach or suggest a cushioning body. As such, *Umezawa* fails to teach or suggest the electromagnetic wave generating unit is arranged on one side of the cushioning body and the board is arranged on another side of the cushioning body. *Hsu* fails to cure the deficiencies of the teachings of *Umezawa* as *Hsu* fails to

teach or suggest the electromagnetic wave generating unit is arranged on one side of the cushioning body and the board is arranged on another side of the cushioning body.

It is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103(a) by failing to provide references that teach or suggest all of the elements as recited in the claims. As such, claim 12 is patentable over *Umezawa* in view of *Hsu*.

- b. There is no motivation to combine the references in support of the rejection of claim 12

In support of the Examiner's rejection of claim 12, the Examiner fails to assert any motivation as to why one skilled in the art would be motivated to combine the purported teachings of *Hsu* with the purported teachings of *Umezawa* to provide for the electromagnetic wave generating unit is arranged on one side of the cushioning body and the board is arranged on another side of the cushioning body. The Examiner's statement of motivation is merely directed to the element of claim 11.

As the Examiner has failed to provide any motivation for the purported combination, the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103(a).

- c. The rejection of claim 12 relies on impermissible hindsight

By asserting that it would have been obvious to modify *Umezawa* to include any feature of *Hsu* with no suggestion or motivation in the applied references or elsewhere to do so, the rejection again appears to rely on impermissible hindsight reasoning.

For all of the above reasons, Appellant maintains that claim 12 is allowable over the references as cited.

- 4. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 14

Claim 14 depends from claim 13. Appellant submits that the rejection under 35 U.S.C. § 103(a) based on the combination of *Umezawa* in view of *Hsu* fails to establish *prima facie* obviousness of claim 14 for at least the reasons set forth above concerning claim 13. Appellant also submits that dependent claim 14 is separately patentable and offers the following additional argument for the invention of claim 14.

The invention of claim 14 is directed to a board wherein the content is arranged on one side of the container and the board is arranged on another side of the container.

In support of the Examiner's rejection of claim 14, the Examiner asserts in the Final Official Action mailed September 30, 2005, on page 3 as follows:

Re claims 11, 12 and 14, Umezawa et al. teaches wherein the invention is used for electronic devices. However, Umezawa et al. does not teach wherein the equipment comprises a board. Hsu teaches where a container with a shield (100) comprises a board (52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a board in the invention of Umezawa et al. since it is well known to those of ordinary skill in the art that shields are used with boards in order to reduce interference among components.

a. The Examiner fails to address any elements as recited in claim 14

The Examiner failed assert the teachings of *Umezawa* or *Hsu* on any of the elements of claim 14.

b. There is no motivation to combine the references in support of the rejection of claim 14

In support of the Examiner's rejection of claim 14, the Examiner fails to assert any motivation as to why one skilled in the art would be motivated to combine the purported teachings of *Hsu* with the purported teachings of *Umezawa* to provide a board wherein the content is arranged on one side of the container and the board is arranged on another side of the container. The Examiner's statement of motivation is merely directed to the element of claim 11.

As the Examiner has failed to provide any motivation for the purported combination, the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103(a).

c. The rejection of claim 14 relies on impermissible hindsight

By asserting that it would have been obvious to modify *Umezawa* to include any feature of *Hsu* with no suggestion or motivation in the applied references or elsewhere to do so, the rejection again appears to rely on impermissible hindsight reasoning.

For all of the above reasons, Appellant maintains that claim 14 is allowable over the references as cited.

5. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 11

Claim 11 depends directly from claim 1. Appellant submits that the rejection under 35 U.S.C. § 103(a) based on the combination of *Umezawa* in view of *Hsu* fails to establish *prima facie* obviousness of claim 11 for at least the reasons set forth above concerning claim 1. Appellant also submits that dependent claim 11 is separately patentable and offers the following additional argument for the invention of claim 11.

The invention of claim 11 is directed to a heat radiating elastic member which is directly coupled to a board having a circuit.

In support of the Examiner's rejection of claim 11, the Examiner asserts in the Final Official Action mailed September 30, 2005, on page 3 as follows:

Re claims 11, 12 and 14, Umezawa et al. teaches wherein the invention is used for electronic devices. However, Umezawa et al. does not teach wherein the equipment comprises a board. Hsu teaches where a container with a shield (100) comprises a board (52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a board in the invention of Umezawa et al. since it is well known to those of ordinary skill in the art that shields are used with boards in order to reduce interference among components.

7

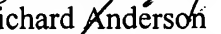
Hsu.

X. CONCLUSION

Final Office Action should be reversed.

9a ✓

Respectfully submitted,

By 
D. Richard Anderson
Registration No.: 40,439
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

CLAIMS APPENDIX A

1. (Previously Presented) A cushioning body comprising:

a heat radiating elastic member arranged around an electromagnetic wave generating unit to provide cushioning for protection from physical shock and radiate heat generated by the electromagnetic wave generating unit; and

an electromagnetic wave blocking member arranged in the heat radiating elastic member.

2. (Withdrawn) The cushioning body as claimed in claim 1, wherein the electromagnetic wave blocking member is ferrite particles dispersed in the heat resistant elastic member.

3. (Withdrawn) The cushioning body as claimed in claim 2, wherein the ferrite particles are locally distributed in the heat resistant elastic member.

4. (Withdrawn) The cushioning body as claimed in claim 1, wherein the electromagnetic wave blocking member is a mixture of a shock absorbing oil and an electromagnetic wave absorbing member and is wrapped by an outside skin formed of the heat resistant elastic member.

5. (Previously Presented) The cushioning body as claimed in claim 1, wherein the electromagnetic wave blocking member is a metal sheet arranged in the heat radiating elastic member.

6. (Original) The cushioning body as claimed in claim 5, wherein the metal sheet has a roughened surface.

7. (Withdrawn) A cushioning body comprising:

a heat resistant elastic member arranged around an electromagnetic wave generating unit;
and

an electromagnetic wave blocking member, wherein
the heat resistant elastic member is made of shock absorbing gel; and
the electromagnetic wave blocking member is a metal frame for fixing the shock absorbing gel.

8. (Cancelled)

9. (Previously Presented) The cushioning body as claimed in claim 1, wherein the heat radiating elastic member has resistance to heat generated by the electromagnetic wave generating unit.

10. (Previously Presented) The cushioning body as claimed in claim 1, wherein the heat radiating elastic member isolates the electromagnetic wave generating unit from vibrations.

11. (Previously Presented) The cushioning body as claimed in claim 1, wherein the heat radiating elastic member is directly coupled to a board having a circuit.

12. (Previously Presented) The cushioning body as claimed in claim 11, wherein the electromagnetic wave generating unit is arranged on one side of the cushioning body and the board is arranged on another side of the cushioning body.

13. (Previously Presented) A container, comprising

a heat radiating receptacle which radiates heat generated by a content not to heat up the content and provides cushioning for protection from physical shock; and

a shield which isolates electromagnetic waves which is included in the receptacle.

14. (Previously Presented) The container as claimed in claim 13, further comprising a board, wherein the content is arranged on one side of the container and the board is arranged on another side of the container.

EVIDENCE APPENDIX B

None.

RELATED PROCEEDINGS APPENDIX C

None.